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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,096	08/06/2001	Sten Frolich	AN06187US/3161	9489

7590 12/18/2003

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EXAMINER

CHIN, PETER

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,096

Applicant(s)

FROLICH ET AL.

Examiner

Peter Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 3,7,9,20,21,23,30-36 and 44-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8,10-19,22,24-29 and 37-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12/7/01. 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election with traverse of the species in responses received on 4/7/2003 and 9/22/2003 is acknowledged. The traversal is on the ground(s) that there is no serious burden imposed on the Office. This is not found persuasive because the election is based on patentable distinct species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3,7,9,20,21,23,30-36,44-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in responses received on 4/7/2003 and 9/22/2003

Note that the elected species are: cationic polysaccharide as the cationic organic polymer (i) and the ultimate species of anionic step growth polymer (ii), naphthalene sulfonate condensation polymer.

3. Claims 1,4-6,10,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Begala (5,595,629).

The claims are clearly anticipated by Begala, see especially the claims.

4. Claim 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Begala (5,595,629) with or without Struck et al (WO 9955962), Persson et al (WO 9955964) or Cauley et al (5,514, 249).

Recycling white water is conventional practice in the art. In regard to claim 12, white water and the slurry water in general have electrolytes in the form of anionic trash and added anionic substances such as fillers and size, which are reflected in the

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conductivity value of the slurry. The claimed conductivity is common in the paper making slurry or stock and if evidence is required see page 10 of Struck et al, page 12 of Persson et al and last paragraph of column 4 spanning column 5 of Cauley et al.

5. Claims 1,2,4-6,8,10-19,22,24-29 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson et al (WO 9955964) in view of Begala (5,595,629).

Persson shows the claimed invention except for the specific anionic condensation polymer (page 7 for the use of anionic condensation polymer). Begala teaches that naphthalene sulfonate condensation polymer used in conjunction with cationic polymers containing aromatic groups improves retention, drainage and formation. Thus, it would have been obvious to employ naphthalene sulfonate condensation product as the anionic condensation polymer in Persson et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Chin whose telephone number is (703) 308-2046. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Peter Chin
Primary Examiner
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